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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,774

08/13/2007

Delphine Blanc-Magnard

PLAS-034

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32954

7590

11/04/2009

JAMES C. LYDON

100 DAINGERFIELD ROAD

SUITE 100

ALEXANDRIA, VA 22314

EXAMINER

NELSON, LINDSAY ANN

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/584,774	Applicant(s) BLANC-MAGNARD ET AL.	
	Examiner LINDSAY NELSON	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-40 and 43-60 is/are rejected.
- 7) ☒ Claim(s) 41 and 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/28/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 46 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

3. Claim 46 refers to MD_pM siloxanes, but M and D are not defined in the claims, nor in the specification. For the purposes of examining, it will be assumed that M and D stand for mono and difunctional organosiloxy units.

4. Claim 60 provides for the use of the claimed catalyst, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 60 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an

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improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

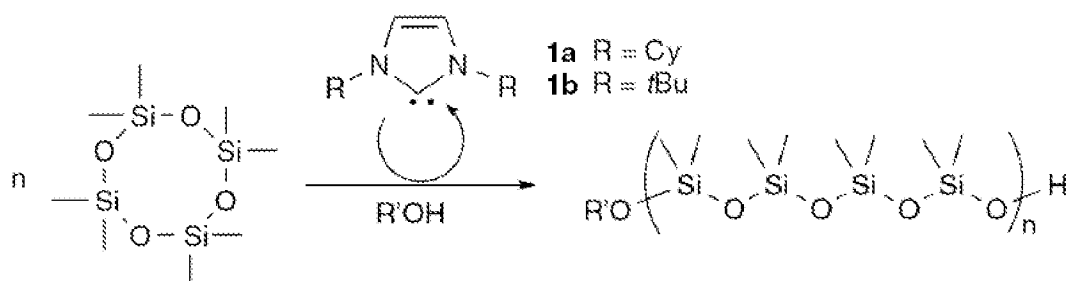
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

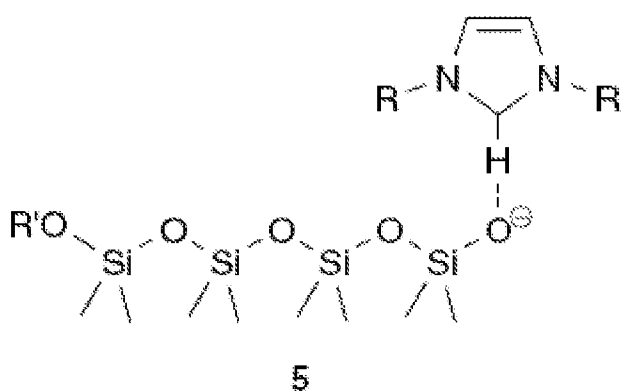
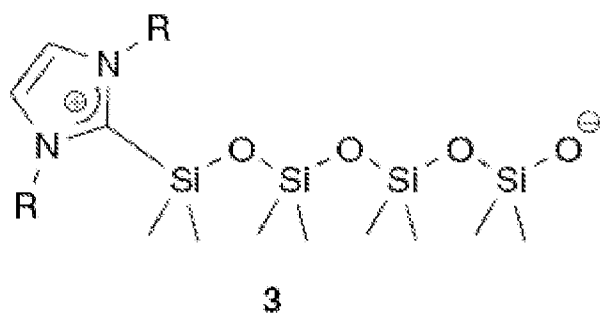
2. Claims 28-39 and 43-60 are rejected under 35 U.S.C. 102(a) as being anticipated by Rodriguez, et al, Journal of Organometallic Chemistry 692 (2007) 705-708.

3. Regarding claims 28-32, 40, 46-48, and 52 Rodriguez discloses using a N-heterocyclic carbene catalyst in the ring-opening polymerization of cyclotetrasiloxane (abstract) by the following Scheme:

Scheme 1. ROP of D_4 catalyzed by NHC **1a,b**.

which reads on the claimed method.

4. Regarding claims 33-35 and 49-50, Rodriguez further discloses that the NHC carbene catalyst is prepared by the deprotonation of the corresponding imidazolium triflate with potassium hexamethyldisilazide (2. Results and Discussion, Paragraph 1) which reads on the claimed method.
5. Regarding claims 36-37, Rodriguez further discloses that THF is used in the reaction (2. Results and Discussion, Paragraph 1) which reads on the carbene being at least partially solubilized and on the solubilization helper.
6. Regarding claim 38, Rodriguez further discloses that the mixture above is heated at 80 °C for 16 hours (2. Results and Discussion, Paragraph 1) which reads on the claimed temperature range.
7. Regarding claims 39 and 51, Rodriguez further discloses that the concentration of carbene catalyst used is 1000 ppm (Table 1) which reads on the claimed concentration of catalyst.
8. Regarding claims 43-45 and 54-59, Rodriguez further discloses formulas 3 and 4 as shown below, which reads on the claimed composition.



9. Regarding claim 53, Rodriguez further discloses that about 85% of the monomers of the initial composition are converted (2. Results and Discussion, Paragraph 1) which reads on the claimed composition.

Allowable Subject Matter

10. Claims 41-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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11. The following is a statement of reasons for the indication of allowable subject matter:

12. The closest prior art, Rodriguez, discloses the above composition and reaction method, but does not disclose using linear polyorganosiloxanes of the formula in instant claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSAY NELSON whose telephone number is (571)270-7735. The examiner can normally be reached on Monday - Thursday, 9 am - 5 pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LN

/Randy Gulakowski/
Supervisory Patent Examiner, Art Unit 1796